

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

REMARKS

Claims 1-20 and 22-42 have been examined on their merits.

Applicants herein amend claims 1, 4, 10, 18, 28, 39 and 40. The amendments do not add any new matter, require further search and/or consideration on the part of the Examiner, and place the application in better form for appeal. Entry of the amendments to claims 1, 4, 8, 10, 18, 28, 39 and 40 is requested.

1. Claims 1, 4, 10, 18, 28, 39 and 40 stand rejected under 35 U.S.C. § 112 (1st para.) as allegedly being indefinite. Applicants traverse the § 112 (1st para.) rejection of claims 1, 4, 10, 18, 28, 39 and 40 for at least the following reasons.

As disclosed in the specification, a customer makes a trade request to buy or sell points. Referring to Figure 4 of the instant specification, the customer wants to buy member shop points of A airlines and A oil company and sell member shop points of A shoes, B airlines, B shopping club, and B oil company. The trade request information is sent to the transaction processing unit, which stores the trade request information in the transaction database and performs trading of points according to the received trade request information. The transaction of points the customer wants to sell is carried out when another customer wants to buy the points. When another customer requests to buy the points, the transaction processing unit receives the request for buying the points from the customer, checks whether or not points for sale corresponding to the buying request exist in the transaction database and if points for sale satisfying the buying request exist, the transaction is processed. Using Figure 4 as an example, if the customer wants

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

to buy points of B airlines, the transaction processor will carry out the customer's request. See pg. 7, line 24 to pg. 8, line 9 of the instant specification.

The Examiner alleges that the recitation of "wherein, in exchange for the trading points for a first type of goods or services, the first customer receives either a monetary equivalent or trading points for a second type of goods or services from the at least one other customer" in claims 1, 4, 8, 10, 18, 28, 39 and 40 somehow requires that the first and second customers deal directly with each other. Critically, the Examiner has utterly failed to explain how the above recitation requires that the first and second customers deal directly with each other. However, in order to advance the prosecution of this application, Applicants herein amend claims 1, 4, 8, 10, 18, 28, 39 and 40 to recite that the transfer of trading points or a monetary equivalent is handled by the transaction processor.

Based on at least the foregoing reasons, Applicants submit that § 112 (1st para.) rejection of claims 1, 4, 8, 10, 18, 28, 39 and 40 has been overcome, and request withdrawal of same.

2. Claims 1-20 and 22-42 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Postrel (U.S. Patent No. 6,594,640) in view of Millard *et al.* (U.S. Patent Publication No. 2002/0007335 A1). Applicants traverse the § 103(a) rejection of claims 1-20 and 22-42 for at least the reasons discussed below.

The combination of Postrel and Millard *et al.* fails to teach or suggest at least the exchange of trading points between two customers, wherein the exchange comprises one type of trading points being exchanged for a monetary equivalent or a second type of trading points, as

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

well as several other features recited in claim 1. The Patent Office alleges that the combination of Postrel and Millard *et al.* discloses carrying out a request to trade trading points between a first customer and at least one other customer at a transaction processor, and the Patent Office cites col. 1, lines 22-26 and col. 5, lines 61-67 of Postrel as evidence of such teaching. While the cited text at col. 1, lines 22-26 of Postrel discloses the purchase of points, Postrel clearly states that the “system would also allow for purchase by users of points *traded in* by other users....” In other words, the combination of Postrel and Millard *et al.* discloses that the users can purchase additional points *subsequent* to their redemption by other users. There is no teaching or suggestion in the cited text that the purchase of the points occurs prior to their redemption by other users. Moreover, there is no teaching or suggestion in the cited text that any sort of exchange, without prior redemption, occurs between customers. With respect to the disclosure at col. 5, lines 61-67 of Postrel, Applicants submit that this is cumulative of the citation at col. 1, lines 22-26. The cited passage discusses the repurchase of points from issuers, and not the trading of points between customers.

In the Response to Arguments section of the October 20, 2005 Final Office Action, the Examiner states that claims do not recite that the point exchange has to occur prior to their redemption, and thus, the combination of Postrel and Millard *et al.* renders the claims obvious. However, the Examiner’s view of the language of claim 1 clearly misapprehends both the plain language of claim 1, as well as the teachings of the prior art. Claim 1 clearly recites that the point exchange is between two individuals that are customers of one or more business organizations. A trade between two individuals is not a redemption in the sense disclosed by the

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

combination of Postrel and Millard *et al.*, wherein existing points are redeemed for goods and services by one individual, and those points are reissued to another individual based on a subsequent purchase. The combination of Postrel and Millard *et al.* does not teach or suggest transfer of trading points between two customers, but instead requires an intervening redemption and purchase/reissue process. In claim 1 of the present invention, the very nature of what is being exchanged, *i.e.*, trading points (see pg. 1, lines 10-22 of the present invention), is indicative of Applicants' position that redemption has not occurred at the time of exchange between the two individuals.

In addition, the combination of Postrel and Millard *et al.* lacks any teaching or suggestion of an exchange of different types of trading points between customers. Although the Patent Office alleges that col. 6 of Postrel teaches the exchange of trading points between two customers, in actuality the combination of Postrel and Millard *et al.* teaches the aggregation of reward points, which are stored in different accounts all belonging to the same customer, for the purpose of redemption. For example, col. 6, lines 12-45 of Postrel discuss the initiation of a redemption request by a trading server that contacts an airline reward server to redeem a customer's points. However, col. 6, lines 53-67 of Postrel are clear that other reward servers (all of which have accounts for the identical customer) are contacted for point aggregation purposes, and the points stored therein are used for redemption as well. It is clear that the different types of points disclosed in the combination of Postrel and Millard *et al.* are aggregated together for redemption purposes. There is no teaching or suggestion in the combination of Postrel and Millard *et al.* that the different types of trading points are exchanged, for example, between

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

various customers of the credit card reward server (12), the airline reward server (10) and the marketing reward server (14).

In the Response to Arguments section of the October 20, 2005 Final Office Action, the Examiner states that Postrel discloses that the “present invention relates to electronic bartering systems that allow users to trade or redeem points.” *See* col. 1, lines 14-15 of Postrel. Applicants submit that the above disclosure is legally insufficient to fulfill the requirements for a *prima facie* case of obviousness. Furthermore, as discussed above, the use of the word “trade” in the above-cited text of Postrel is cumulative of the word “redeem” when viewed in light of the above discussion (see previous paragraph) about what Postrel truly discloses, and which the Examiner has chosen not to rebut in the October 20, 2005 Final Office Action.

Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants submit that one of skill in the art would not be motivated to combine Postrel with Millard *et al.* Although Millard *et al.* discloses the generation of revenues from transaction processing, neither reference teaches or suggests the exchange of trading points between customers (as opposed to the exchange of points between an issuer and customer) nor does either reference teach or suggest trading different types of points between two or more customers. Since there is at least no teaching or suggestion of exchanging of different types of trading points between customers, then there can be no motivation to combine the two references. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczaak* and *In re Zurko*.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

Based on the foregoing reasons, Applicants submit that the combination of Postrel and Millard *et al.* fails to teach or suggest all of the claimed elements as arranged in claim 1. Thus, Applicants submit that claims 1 is allowable, and further submit that claims 2 and 3 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 1-3.

With respect to claim 4, Applicants submit that claim 4 is in condition for allowance over the combination of Postrel and Millard *et al.* for at least reasons analogous to those discussed above for claim 1, and further submit that claims 5-9 are allowable as well, at least by virtue of their dependency from claim 4. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 4-9.

With respect to claim 10, Applicants submit that claim 10 is in condition for allowance over the combination of Postrel and Millard *et al.* for at least reasons analogous to those discussed above for claim 1, and further submit that claims 11-17 are allowable as well, at least by virtue of their dependency from claim 10. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 10-17.

With respect to claim 18, Applicants submit that claim 18 is in condition for allowance over the combination of Postrel and Millard *et al.* for at least reasons analogous to those discussed above for claim 1, and further submit that claims 19-27 are allowable as well, at least by virtue of their dependency from claim 18. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 18-27.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

With respect to claim 28, Applicants submit that claim 28 is in condition for allowance over the combination of Postrel and Millard *et al.* for at least reasons analogous to those discussed above for claim 1, and further submit that claims 29-38 are allowable as well, at least by virtue of their dependency from claim 28. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 28-38.

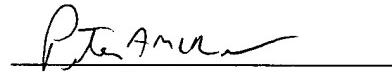
With respect to claims 39 and 40, Applicants submit that claims 39 and 40 are in condition for allowance over the combination of Postrel and Millard *et al.* for at least reasons analogous to those discussed above for claim 1, and further submit that claims 41 and 42 are allowable as well, at least by virtue of their dependency from claim 40. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 39-42.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 09/751,391
ATTORNEY DOCKET NO. Q62029

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Peter A. McKenna
Reg. No., 38,551

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: December 20, 2005